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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,184	01/28/2005	John J.R. Mertens	1592 WO/US	8281

7590 07/12/2006

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EXAMINER

CHU, YONG LIANG

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/523,184	Applicant(s) MERTENS, JOHN J.R.	
	Examiner Yong Chu	Art Unit 1626	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.  
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6 and 9-11 is/are pending in the application.  
 4a) Of the above claim(s) 2 is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1,3,5,6 and 9-11 is/are rejected.  
 7) ☒ Claim(s) 1,3,5,6,10, and 11 is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/2/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

The amendment to the Specification and Drawings have been considered, and entered.

Claims 1, 3, 5, and 6 are amended by amendment filed on 2 June 2006 and have been entered. Claim 2 stands withdrawn. Therefore, claims 1-3, 5, 6, and 9-11 are pending in the instant application. Claims 1, 3, 4, 5, 6 and 9-11 are ready for examination.

### ***Information Disclosure Statement***

Applicant's Information Disclosure Statements, filed on 2 June 2006 has been considered. Please refer to Applicant's copies of the 1449 submitted herewith.

### ***Response to Arguments***

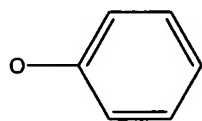
- **Claim Rejection Under 35 U.S.C. §102(b)**

Applicant's argument on claim 3 is persuasive after considering the amendment of claim 3 filed on 6/2/2006. Therefore, the rejection over claim 3 is withdrawn.

Applicant's argument on claim 1 has been considered and find not persuasive, because the term "substituted aromatic" which can be (-O-), anticipated by the Wester et al. reference. Since "substituted" is not defined in the Specification, the Examiner should give the broadest interpretation in claim 1. Applicants' explanation "based on the new approach to introduce an alkyl side chain on the phenyl ring to facilitate

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introduction of the radioactive atom" is fully considered. However, claim 1 defines the invention differently from the argument. There is no exclusion of R as being

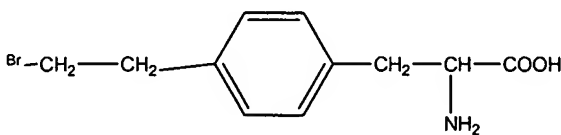


based on the term "substituted aromatic" in claim 1. To overcome the rejection, Applicants have to amend claim 1 to exclude the compound taught by Wester et al. reference. Therefore, the rejection over claim 1 maintains.

It should be mentioned that claim 1 is a compound (product type) claim, not a process to make or process to use type claim. Only chemical identity of the compounds are considered, not how the claimed compounds are made and intend to use, which will be considered in the process type claim. Divisional process to use type claim might be an alternative.

- **Claim Rejection Under 35 U.S.C. §103(a)**

Applicant's argument on claims 1, 3, 5-6, and 9-11 is not persuasive. Wester et al. teach a radioactive halogenated amino acid analog with  $^{18}\text{F}$  labeled group attached to the amino acid analog, even though it does not teach exactly the compounds of the instant application. However, the second reference by Sheffer-Dee-Noor et al. teach a

non-radioactive compound  wherein the amino acid phenyl group is substituted with halogen alkyl group, which is obvious to one skilled in the art in considering combined the Wester reference. The motivation for combining such two references is that the Wester reference is also used as radioactive tracer.

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There is no requirement for **both** references having the similar utilities as application do.

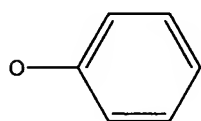
Therefore, the rejection over claims 1, 3, 5-6, and 9-11 maintains.

- **Claim Rejection Under 35 U.S.C. §112 1<sup>st</sup> paragraph**

Applicant's argument on claims 1, 3, and 9 is persuasive. The rejection over claims 1, 3, and 9 is withdrawn.

- **Claim Rejection Under 35 U.S.C. §112 2<sup>nd</sup> paragraph**

Applicant's argument on claim 1 is not persuasive. The examples of "substituted" on page 5-6 of the Specification are example, not definition. For example, on rejected claim 1, the Examiner interpretate the substituted aromatic ring can include



, but Applicants do not agree. The limit and boundary of R is indefinite.

That is the reason for this rejection. Therefore, rejection over claim 1 remains.

### ***Claim Objections***

Claims 1, and 3 are objected to as containing withdrawn subject matters (R is (C<sub>1</sub>-C<sub>6</sub> alkyl...see scope of invention), but would be allowable if rewritten in appropriate form including all of the limitations of the base claim and any intervening claims.

Claims 5, 6, 10 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

No claims are allowed.

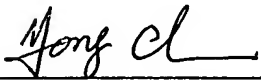
**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

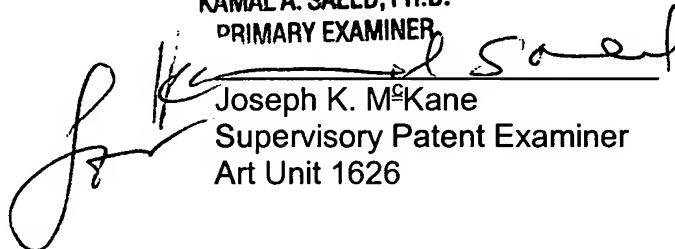
***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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